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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,495	12/05/2003	Alan C. Berkema	200310639-1	9731

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EXAMINER

HOANG, DANIEL L

ART UNIT	PAPER NUMBER
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2136

NOTIFICATION DATE	DELIVERY MODE
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06/06/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/728,495	Applicant(s) BERKEMA ET AL.	
	Examiner DANIEL L. HOANG	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,10-18,21,23-32 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2, 10-18, 21,23-32, 40-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

RESPONSE TO ARGUMENTS

Applicant's arguments filed 3/31/08 have been fully considered but they are not persuasive.

Applicant has amended claim language to include the limitation that the printing device generates the PIN without communicating with a claimant device. Applicant alleges that the Willey and Phillips references do not teach generating the PIN without communicating with a claimant device. While this may or not be true, examiner believes the above limitation is not in concurrence with applicant's specification. Not only does the specification not disclose that the PIN is generated without communicating with a claimant device, communication may exist to an extent. Paragraph 31 of applicant's disclosure teaches of associating the PIN with expiration as well as access data. It is unclear whether this requires communication with claimant device or not. Nevertheless, the exclusion of claimant device communication is not taught. Therefore, whether or not the applied references contain this limitation is currently a moot point. This issue is further addressed below in a 112 rejection.

CLAIMS PRESENTED

Claims 1, 2, 10-18, 21, 23-32, 40-49 are pending.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a

way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

2. Claim 1 recites generating a PIN without communicating with the claimant device. Applicant does not disclose said limitation. Pending independent claims with the same limitation are also similarly rejected. Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 cites generating a PIN without communicating with the claimant device. It is unclear how this limitation can occur based on what is disclosed in applicant's specification. Furthermore, examiner interprets based on applicant's disclosure that communication is necessary. For purposes of examination, examiner interprets the claim language to be in line with applicant's disclosure, which necessitates communication between the claimant device and the PIN module. Appropriate correction is required. Independent claims with said limitation are also similarly rejected.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 31, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willey, US PGP No. 20030065918.

As per claim 1, 31, 48, Willey teaches:

A method for publishing a PIN for use in establishing a pairing between a claimant device and with a printing device, comprising:

the printing device detecting a local PIN request made by activation of a user interface control element provided by the printing device;

[see paragraph 38]

the printing device generating the PIN in response to [[a]] the local PIN request and without communicating with the claimant device; and the printing device printing the PIN;

[see paragraph 41]

receiving a connection request from the claimant device, the connection request including PIN data assembled from the PIN; and

[see paragraph 48]

generating a link key using the PIN data, the link key used for device pairing between the claimant device and the printing device.

[see paragraph 48]

3. Claims 2, 10-12, 40-42, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willey as applied to claim 1 or 5 above, and further in view of Slick et al., US PGP No. 20030105963.

As per claim 2, 48:

The method of claim 1, identifying a local request to print a test page as the local PIN request and wherein printing the PIN comprises printing a test page that includes the PIN.

The Willey reference has been discussed above. Willey does not explicitly disclose identifying a local request to print a test page as the local PIN request wherein printing the PIN comprises printing a test page that includes the PIN.

The Slick reference teaches the above limitation not disclosed by Willey (see Slick, paragraph 0019). It would have been obvious to one of ordinary skill in the art to combine the above teachings of Willey with that which is taught by Slick so that a user "can view the predetermined [PIN] from the test page and then enter the [PIN] into the computing device".

As per claim 10, 40, Willey teaches:

The method of claim 1, further comprising determining the validity of the PIN data prior to generating the link key.

[0048]

As per claim 11, 41, Willey teaches:

The method of claim 10, wherein determining includes determining if the PIN data corresponds to the PIN, determining if the generated PIN has expired, and rejecting the connection request if the PIN data does not correspond to the PIN or if the PIN has expired.

[0043-0047]

As per claim 12, 42:

Claim 12 reads as follows:

The method of claim 5 further comprising rejecting the connection request if the connection request is for a function not associated with the PIN data.

The Willey reference does not explicitly teach to reject a connection request if the request is for a function not associated with the PIN data. The PIN data identifies the device seeking connection. It would be

obvious the reject the connection request from a device such as a headset seeking to communicate with a printer because a headset would have no need to connect with a printer.

5. Claims 13, 23, 26, 30, 31, 43, are rejected 35 U.S.C. 103(a) as being unpatentable over Willey, further in view of Phillips, US Patent No. 6748195.

As per claim 13, 23, 26, 30, 31, 43:

Willey teaches:

A method for establishing a pairing between a claimant device and a verifying device, comprising:

detecting a local PIN request made by activation of a user interface control element provided by the verifying device;

[see paragraph 38]

generating a PIN in response to the local PIN request and without communicating with the claimant device;

[see paragraph 41]

instructing the verifying device to print the PIN;

[see paragraph 42]

receiving from the claimant device a connection request, the connection request including PIN data;

[see paragraph 48]

determining whether a link key exists for the verifying device;

[see paragraph 48]

if a link key exists:

~~rejecting the connection request if the verifying device is not multi-claimant enabled;~~

~~rejecting the connection request if the verifying device is multi-claimant enabled with restricted access and the claimant device is not approved;~~

otherwise, upon a determination that the PIN data is valid, generating a link key from the PIN data to establish a pairing between the claimant device and the verifying device.

[see paragraph 48]

Willey is mute in teaching rejecting the connection request of the verifying device is not multi-claimant enabled. For this limitation, examiner relies upon the Phillips reference. Col. 7, lines 3-17, Phillips teaches disabling a device when it is "out of the office". It would be obvious to one of ordinary skill in the art to modify the Willey invention to include that which is taught by Phillips so that devices can be disabled for security reasons and for conservation of resources, etc. (col. 7, lines 13-15)..

As per claim 15, 28, 45:

The method of claim 14, wherein the PIN and the PIN data are of the same format and wherein determining the validity of the PIN data includes determining if the PIN data matches the generated PIN.

Phillips does not explicitly disclose verification of PIN data. Willey teaches this limitation, (see Willey, paragraph 0050). It would have been obvious to combine this teaching of Willey with the Phillips reference in order to validate the PIN. Validating the PINs ensures both devices are verified to communicate with each other.

As per claim 16, 29, 46:

The method of claim 14, wherein determining the validity of the PIN data comprises: acquiring a unique identifier for the claimant device; constructing verifying PIN data using the unique identifier and the generated PIN; determining if the PIN data matches the verifying PIN data.

Phillips does not explicitly disclose verification of PIN data. Willey teaches this limitation, (see Willey, paragraph 0050). It would have been obvious to combine this teaching of Willey with the Phillips

reference in order to validate the PIN. Validating the PINs ensures both devices are verified to communicate with each other.

As per claim 17, 18, 30, 47:

A method for establishing a pairing between a claimant device and a printing device, comprising:
generating a PIN in response to a local request to print a test page made to the printing device;

detecting a local request to print a test page made by activation of a user interface control element provided by the printing device.

[see rejection of claims 1 and 2]

instructing the printing device to print a test page that includes the PIN;

[see rejection of claim 2]

receiving from the claimant device a connection request, the connection request including PIN data;

[Phillips, col. 5, lines 48-59]

determining whether a valid link key exists exist for the printing device;

[Phillips, col. 5, lines 59-65]

if a valid link key exists:

rejecting the connection request if the printing device is not multi-claimant enabled;

[Phillips, col. 7, lines 3-17]

rejecting the connection request if the printing device is multi-claimant enabled with restricted access and the claimant device is not approved;

[Phillips, col. 7, lines 3-17]

otherwise, upon a determination that the PIN data is valid, generating a link key from the PIN data to establish a pairing between the claimant device and the printing device.

[Phillips, col. 6, lines 1-10]

As per claim 21, 32:

The method of claim 18, identifying a local request to print a test page as the local PIN request and wherein printing the PIN comprises printing a test page that includes the PIN.

The Willey reference has been discussed above. Willey does not explicitly disclose identifying a local request to print a test page as the local PIN request wherein printing the PIN comprises printing a test page that includes the PIN.

The Slick reference teaches the above limitation not disclosed by Willey (see Slick, paragraph 0019). It would have been obvious to one of ordinary skill in the art to combine the above teachings of Willey with that which is taught by Slick so that a user "can view the predetermined [PIN] from the test page and then enter the [PIN] into the computing device".

As per claim 23, Willey teaches:

The medium of claim 18, having further instructions for determining the validity of the PIN data prior to generating the link key.

[0048] It would have been obvious to combine this teaching of Willey with the Phillips reference in order to validate the PIN. Validating the PINs ensures both devices are verified to communicate with each other.

As per claim 24, Willey teaches:

The medium of claim 23, wherein the instructions for determining include instructions for determining if the PIN data corresponds to the PIN, determining if the generated PIN has expired, and rejecting the connection request if the PIN data does not correspond to the PIN or if the PIN has expired.

[0043-0047] It would have been obvious to combine this teaching of Willey with the Phillips reference in order to validate the PIN. Validating the PINs ensures both devices are verified to communicate with each other.

As per claim 25:

The medium of claim 18, having further instructions for rejecting the connection request if the connection request is for a function not associated with the PIN data.

The Willey reference does not explicitly teach to reject a connection request if the request is for a function not associated with the PIN data. The PIN data identifies the device seeking connection. It would be obvious to reject the connection request from a device such as a headset seeking to communicate with a printer because a headset would have no need to connect with a printer.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

POINTS OF CONTACT

*. Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Application/Control Number:
10/728,495
Art Unit: 2136

Page 11

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401 Dulaney Street
Alexandria, VA 22314

*. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Hoang whose telephone number is 571-270-1019. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Hoang
12/18/07

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit 2136